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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

31083.072US2

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on SEPTEMBER 8, 2005

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Application Number

10/649,277

Filed

8/27/03

First Named Inventor

GEOFFREY A. WESTPHAL

Art Unit

2623

Examiner

LaRose, Colin M.

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

applicant/inventor.

assignee of record of the entire interest.

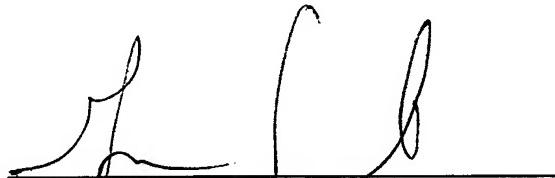
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

attorney or agent of record.

Registration number 35,906

attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____


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SEPTEMBER 8, 2005

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.

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This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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REASONS FOR THE REQUEST

In the Office Action of July 13, 2005 pending claims 1-25 and 27-39 were finally rejected as being rendered obvious under 35 U.S.C. § 103 by the combination of Takagi (U.S. Patent No. 5,489,893), Lee (U.S. Patent No. 5,635,984) and Kutch (U.S. Patent No. 5,164,831) – also considering Kagle (U.S. Patent No. 6,148,149) and Higgins (U.S. Patent No. 5,835,627) - or by the combination of Takeda (U.S. Patent No. 5,343,560) and Kagle.

In response it is respectfully submitted that obviousness cannot be established by combining the prior art to produce the claimed invention absent some teaching or suggestion supporting the combination. Still further, the mere fact that the prior art may be modified in the manner suggested does not make the modification obvious unless the prior art suggested the desirability of the modification.

With respect to the rejection of claims 1-24 and 28-39, it is respectfully submitted that the reconstruction of Tagaki in view of Lee and/or the reconstruction of Takagi/Lee in view of Kutch that has been advanced in the rejection of these claims is unduly speculative. As such, it is submitted that it is apparent that the only suggestion for combining Tagaki, Lee, and Kutch (as well as Kagle and/or Higgins) in the manner asserted in the rejection stems from hindsight knowledge impermissibly derived from the subject application.

It is respectfully submitted that none of the references cited expresses any appreciation of the space saving advantages attributable to the invention set forth in the claims. (see Response filed on December 7, 2004, pg. 13). Takagi, which is directed to the problems associated with selecting camera image settings, does not disclose, teach, or

suggest the desirability of maximizing usable image storage capacity. That Takagi fails to disclose, teach, or suggest at least the claimed compressing each of a plurality of resultant images and fails to disclose, teach, or suggest the claimed selecting from a plurality of compressed, resultant images created for each original image one compressed, resultant image which may then be placed into memory has been acknowledged in the Office Actions. All Takagi teaches with respect to “selecting” is using a plurality of displayed, predicted images to set a camera for taking a photograph.

As to Lee, Lee discloses a digital camera that addresses the problem of how to view more than one image on a display. Lee does not address the problem of how to maximize usable image storage capacity. Lee describes using a compression method that requires the reading out of image data already stored within memory and then displaying the image with predetermined horizontal and vertical lines omitted. Thus, when Lee is considered in its entirety, as is required, nothing from Lee can be said to suggest the modification of Takagi to arrive at a system that compresses each of a plurality of resultant images and which then selects from the plurality of compressed, resultant images one compressed, resultant image *which is to be thereafter stored* to achieve the advantages achieved by the invention claimed. Furthermore, since the system of Takagi already displays a plurality of images for use in selecting a camera setting, it is not evident why a person of ordinary skill in the art would have found it obvious to reconstruct Takagi using Lee (“in order to display multiple images on a camera screen”) when the espoused objective is far more easily accomplished by simply using the camera of Takagi in its unmodified state.

As to Kutcha, Kutcha discloses “a digital camera that stores images in a format that includes both reduced and high resolution versions of an original image” to offer the advantage of “quick review of images captured by or stored in the camera prior to further processing or selection.” Kutcha, by espousing the storage of both thumbnail images and original images is clearly not concerned with the objective of maximizing usable image storage capacity. It will also be appreciated that Kutcha, when fully and fairly considered in its entirety, teaches directly against the system claimed, i.e., one in which images are processed *prior to* compression, selection, and storage to thereby maximize the number of usable images capable of being stored in memory. Furthermore, it is not evident why a person of ordinary skill in the art would have found it obvious to reconstruct Takagi/Lee using Kutcha (“for simultaneously viewing a plurality of images”) when the espoused objective is far more easily accomplished by simply using the camera of Takagi in its unmodified state. Yet further, it is respectfully submitted that the espoused modification of Takagi/Lee would impermissibly change the principle of operation of at least Lee, i.e., it would change Lee from a system in which original images are required to be stored and thereafter compressed at the time of display to a system which requires compressing images prior to storage and display.

From the foregoing it is submitted that the espoused modification of Takagi in view of Lee and the espoused modification Takagi/Lee in view of Kutcha cannot be said to be supported by the disclosure within these references. Thus, it is respectfully submitted that the requirements for establishing a *prima facie* case of obviousness have not been met and the rejection of claims 1-24 and 28-39 must be withdrawn.

With respect to the rejection of independent claims 25 and 27, it is submitted that Kagle fails to disclose, teach, or suggest that which has been acknowledged in the Office Actions to be missing from Takeda. Kagle describes a system in which a digital camera includes an orientation sensor and, when a picture is taken, the original picture is automatically rotated to correct for camera rotation prior to the picture being stored in the camera or the original picture image is stored in the camera as taken along with the degree of rotation of the camera to thereby allow the original picture image to be rotated to correct for camera rotation when the picture is viewed on a device external to the camera. Thus, Kagle, which is only concerned with displaying original images in a “landscape orientation,” fails to disclose, teach, or suggest the desirability of rotating an original image prior to its being compressed and stored on a device and then using a program on the same device to subsequently rotate an image, after it is decompressed, so that the image can be displayed with the same orientation on the device as the original image from which the decompressed image was created as is required by the claims.

From the foregoing it is respectfully submitted that Kagle fails to provide the requisite suggestion to modify Takeda to arrive at the invention claimed. For this reason, it is respectfully submitted that a *prima facie* case of obviousness has not been established and the rejection of claims 25 and 27 must be withdrawn.